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Eric Verschueren

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LEYDIG VOIT & MAYER, LTD
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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 *Ex parte* ERIC VERSCHUEREN
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13 Appeal 2009-008224
14 Application No. 10/530,394
15 Technology Center 2800
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18 Oral Hearing Held: Wednesday, October 7, 2009
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22 Before EDWARD C. KIMLIN, ADRIENE L. HANLON and MARK
23 NAGUMO, *Administrative Patent Judges*
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27 ON BEHALF OF THE APPELLANTS:
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35

1 The above-entitled matter came on for hearing on Wednesday,
2 October 9, 2009, commencing at 1:00 p.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room A,
4 Alexandria, Virginia, before Janice A. Salas, Notary Public.

5 JUDGE KIMLIN: I guess you can tell us why heating your
6 web above 150 degrees at that time range is nonobvious.

7 MR. GRIFFITH: Right. Okay. I will try to convince you that
8 it is. Again, what we have here -- I think that is the principal argument that
9 permeates our Brief, of course, is that limitation, and I have to say after
10 looking over the Final Office Action, I looked at it to try to identify the
11 portion of the prior art that is allegedly supportive of that rejection.

12 And the only data I could find that supports the rejection is a
13 reference -- I'm looking at page 3 of the Final Office Action. At the bottom
14 it says that "Heating the web, one of the temperatures maintain above 150
15 degrees C," and the Office Action cites paragraph 12, the third example from
16 the bottom of table 1.

17 So if we go to the Kamitani reference, which is the one that I
18 believe is being referred to, that's -- Kamitani is the U.S. publication.

19 JUDGE KIMLIN: That's correct.

20 MR. GRIFFITH: Yeah, and we go to page 10 of that and look
21 down at table 1.

22 JUDGE KIMLIN: Yes.

23 MR. GRIFFITH: Okay. And we go down to the third example
24 from the bottom.

1 JUDGE KIMLIN: The one that has an exit temperature of 153
2 degrees.

3 MR. GRIFFITH: That's correct.

4 JUDGE KIMLIN: Yes. That's what the Examiner's relying on.

5 MR. GRIFFITH: That's right. And if you look at the
6 developability and the overall quality --

7 JUDGE KIMLIN: Not good.

8 MR. GRIFFITH: Not good. In fact, it's not only not good. It
9 says up in paragraph 84 that it's unsatisfactory. So, you know, I think I'm
10 correct in stating this that even under the MPEP, I took a gander at that, and
11 if you look at what is in there about establishing a prima facie case, there's
12 not a prima facie case established.

13 And certainly, when you have the prior art suggesting that using
14 different temperatures, such as this type of situation, and you get reduced
15 yields, charring, decomposition -- I'm looking at the MPEP in 2145,
16 thereabouts -- that's not sufficient to establish obviousness because it's
17 contrary to the accepted wisdom.

18 JUDGE NAGUMO: Well, where's the evidence -- it's not
19 good, but it doesn't say that it was not a lithographic printing plate. That
20 they didn't have an image. I mean, our copiers often give poor quality
21 results, but they're photocopiers, so why is that necessarily bad here?

22 MR. GRIFFITH: Okay. Well, I would say it's bad for a couple
23 of reasons, and again, I'll go back to the MPEP standard that has been
24 unstated on obviousness, and it says that proposed modifications cannot

1 render the prior art unsatisfactory for its intended purpose or change the
2 principal operation of a reference.

3 So here what we would have is a teaching here that if you
4 operate at 153 degrees C, you're going to get an unsatisfactory precursor, so
5 you can't have something that is operating in that claim range that gives you
6 something that's unsatisfactory.

7 I mean, this is what we have here, and in addition to that, I will
8 point out, that back in paragraph 25 of Kamitani, the first line of that, and
9 actually before that in paragraph 24, it talks about the criticality of these
10 temperature ranges.

11 In paragraph 25, it says, quote, specifically, for thermo-type
12 digital direct printing plate, the final temperature of the photosensitive
13 coating layer must -- not may or could -- but must be 125 to 145 degrees C
14 and preferably, 130 to 140 degrees C.

15 So it uses the word "must." So that is critically important to the
16 overall teaching of this reference to one of ordinary skill in the art. One of
17 ordinary skill in the art might look at the data in the table and say, okay, you
18 know, as you suggest, that 153 degrees C may give you something that is
19 somewhat operable. I mean, I don't know if they do that.

20 I don't think that they would do that because it says that what
21 you get is something of unsatisfactory quality, but given what's in paragraph
22 25, that explicit statement in there that is so telling and permeates the entire
23 disclosure that you have to have the temperature, it must be 125 to 145.

1 There is no way one of ordinary skill in the art is going to think
2 that anything, even over 145, is going to give you anything that's going to
3 work.

4 JUDGE KIMLIN: Mr. Griffith, doesn't the reference also make
5 a strong point that the temperature and time of the drying step are closely
6 related to the actual composition of the photosensitive layer, such that they
7 would be result effect the variables for different compositions?

8 MR. GRIFFITH: Where are you pointing to in the reference?

9 JUDGE KIMLIN: Give me a second and I'll find it for you.

10 MR. GRIFFITH: Sure.

11 (Pause in the proceedings.)

12 JUDGE KIMLIN: It's paragraph 24.

13 MR. GRIFFITH: Okay. Let me turn to that.

14 JUDGE KIMLIN: Actually 23 and 24.

15 MR. GRIFFITH: Okay. If you just give me a second please,
16 I'll --

17 JUDGE KIMLIN: Uh-huh.

18 (Pause in the proceedings.)

19 JUDGE KIMLIN: The point being that one of ordinary skill in
20 the art might find it reasonable that the specific time and temperature data
21 given in table 1 are specific only to that particular composition. It would not
22 be necessarily true for other thermo-sensitive compositions.

23 MR. GRIFFITH: Sure. Well, reading those two paragraphs
24 and kind of reading on to -- through 25 and 26, I think the different types of
25 compositions they're discussing are -- as, for example, in paragraph 25, it

1 says, thermal type digital direct printing plates, and then later on it talks
2 about photopolymer type digital direct printing plates, so I think those are
3 the two different types of plates they're talking about.

4 Here we're only talking about the thermal type of printing
5 plates, and when you're talking about that type of printing plate, you are
6 specifically limited by Kamitani to be between 125 and 145 and not higher,
7 and the data -- the only data that's provided in that reference that shows what
8 happens if you go above that, is that it is unacceptable.

9 And that cannot be the basis for an obviousness rejection. That
10 doesn't even meet the prima facie standard. And indeed, after that, when
11 you look at it, it says preferably 130 to 140, so if anything, one of ordinary
12 skill in the art would be taught by Kamitani to keep the temperatures lower,
13 certainly in the 130 to 140 range. So there's absolutely no teaching or
14 suggestion that you could get anything that's remotely functionable or
15 workable if you go up to 150 or higher. And certainly, as claim 2 recites,
16 you get up to 170, there is nothing in this reference that's going to teach one
17 that you could get something that's workable in that range.

18 JUDGE KIMLIN: Would you say it's nonobvious to go against
19 the teaching of the prior art and get the poor results that are predicted by the
20 prior art? In other words, if a reference teaches you not to go above 150
21 degrees and the Applicant goes above 150 degrees, shouldn't he show that he
22 gets comparable results that would have been unexpected?

23 MR. GRIFFITH: Well, I think you're drawing a bit of a fine
24 line there where there might be an overlap situation, but here there is no
25 overlap --

1 JUDGE KIMLIN: No. I'm not talking about an overlap. I'm
2 talking about, say, the reference says above 150 gives bad results.

3 MR. GRIFFITH: Yes.

4 JUDGE KIMLIN: And then an Applicant claims above 150
5 and says, see. The references are teaching away; therefore, going above 150
6 is nonobvious.

7 MR. GRIFFITH: Yes.

8 JUDGE KIMLIN: In such a case, shouldn't the applicant have
9 to show that he gets something other than what the prior art predicted?

10 MR. GRIFFITH: Well, I don't know. I mean, in that case, if
11 the applicant just says you get bad results, perhaps, but here we have the
12 prior art stating that you must be between those two temperature ranges, and
13 it's not -- you know, in claim 1 we have to be above 150 and then in claim 2
14 we have to be above 170.

15 So here it's perhaps a bit different, if I could make this
16 distinction between your scenario and this one, where we have the specific
17 statement in the prior art that you cannot go above 145 and then we have
18 data that supports that, so in this, you know -- I mean, perhaps, under
19 different facts, maybe that is correct, but here, that's just not going to be the
20 case.

21 JUDGE KIMLIN: My point is, regardless of how emphatic the
22 reference states that above, say, 150 is going to give you poor or bad results,
23 shouldn't an applicant have to show that he or she doesn't get those results?

24 MR. GRIFFITH: Well, I think that we --

1 JUDGE KIMLIN: Is it an invention to go against what the
2 prior art teaches and only get what the prior art tells you you're going to get?

3 MR. GRIFFITH: Well, I think -- so you're saying they got bad
4 results and they go above that and then they get good results.

5 JUDGE KIMLIN: My point being is we don't know whether
6 the Applicant here has only gotten the same bad results predicted by the
7 prior art.

8 MR. GRIFFITH: Well, we do have some data at 170 degrees
9 centigrade that shows that we do get very good results.

10 JUDGE KIMLIN: Well, that hasn't been set forth in the Brief.

11 MR. GRIFFITH: That is part of claim 2 that's been argued
12 independently. We have a separate section and that's one of the things I
13 wanted to reference today as well that we set forth different various
14 segregations in the Brief.

15 You'll see 1A, 1B, 1C subheadings, also 2A, 2B subheadings,
16 and then subheading 3 and their request that those claims be looked at kind
17 of independently as independent claim sets and not just grouped into one
18 huge, you know, argument.

19 JUDGE KIMLIN: Right.

20 MR. GRIFFITH: So --

21 JUDGE NAGUMO: I'd like to step back just a moment to
22 figure out what the reference means when it says that the result is
23 unacceptable. If I'm preparing a brief to the Federal Circuit, I've got a
24 certain level of quality that I'm going to insist on from the local copying

1 shop or our own local machines. If I'm preparing something from my own
2 scratches, I'll take almost anything.

3 MR. GRIFFITH: Mm-hmm.

4 JUDGE NAGUMO: Where -- in other words, what's
5 unacceptable can depend on a lot of things. Where -- do we have something
6 in this Kamitani reference that says that they're looking for high quality
7 graphics presentation or just something that works -- gives you something
8 that you can read.

9 Where's the cutoff and how do we tell where -- how strong, in
10 other words, is this you shouldn't go below 150, or whatever that number is,
11 130, you should not go above 140 degrees?

12 MR. GRIFFITH: Sure. No. I understand your question, your
13 concern, and I think, truthfully, that's why, you know, when I've been
14 reviewing this, I've always gone back to paragraph 25 because that seems to
15 give us the most relevant, pertinent teaching as far as what the temperature
16 should be because you can argue all day about perhaps the quality.

17 And I understand what you're saying, and perhaps, you know,
18 in an abstract argument, you can say that, you know, somebody said
19 something is of one quality or another quality and you might not know in an
20 abstract sense, but here, I think, we do have the very specific teaching and
21 that's going to override everything else in this piece of prior art.

22 I mean, we look at the data. Maybe there's a question in your
23 mind about the quality, but if we look at what specifically is in here,
24 paragraph 25 makes it abundantly clear: 125 to 145. End of story.

1 JUDGE KIMLIN: Well, we understand your point. Do you
2 have anything further?

3 MR. GRIFFITH: No. I just wanted to just address briefly the
4 claims 20, 21, and 33. What I can call or what I refer to as the three-phase
5 cooling step that I think provides some advantages. I know the Examiner
6 said that there's -- you know, this is well known in the art, but it's not.

7 I would argue that the three steps -- the fast cooling, slow
8 cooling, fast cooling -- in the context of making lithographic printing plates
9 and making them more -- the sensitivity actually more stable, not just the
10 polymer, but the sensitivity more stable, and more resistance in chemical
11 damage I think are things that are not suggested by this alleged combination.

12 And I guess I'll further notice that, just to wind up, that the
13 Examiner in the Examiner's Answer never addressed paragraph 25, never
14 addressed that teaching at all, so I think that there's something to that, and
15 it's a good solid argument that's a difficult one to get around when you're
16 trying to look at what is the overall teaching of the art in the context of the
17 claims.

18 And, you know, given what's in paragraph 5, there's no
19 variation there. It says what it says and the claims are different, and there's
20 no teaching to go above 145 based on the language of the art.

21 JUDGE KIMLIN: All right. We understand your position.

22 MR. GRIFFITH: Okay. Very good. Well, I appreciate the
23 opportunity.

24 JUDGE KIMLIN: Thank you for appearing before us and
25 calling.

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- 1 MR. GRIFFITH: All right. Well, thank you.
- 2 Whereupon, the proceedings at 1:16 p.m. were concluded.